

REMARKS

Claim 1 has been amended to specify that the bond strength at the interface between the facestock and carrier sheet is less than the yield strength of the facestock. This limitation previously appeared in dependent claim 12, which has now been cancelled. The same limitation is included in newly added claim 22.

In the office action mailed on March 7, 2006, the examiner has taken the position that both Begelfer et al. and Smith inherently disclose bond strengths at the interfaces between the facestocks and carrier sheets that are less than the yield strengths of the facestocks.

However, to establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1268, 20 U.S.P.Q.2D (BNA) 1746, 1749 (Fed. Cir. 1991). "Inherency however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." Id. at 1269, 20 U.S.P.Q.2D (BNA) at 1749 (quoting In re Oelrich, 666 F.2d 578, 581, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981).

It will be seen from paragraphs 4-6 of the accompanying declaration of Philip R. Emery that in Begelfer et al, the adhesive layer 44 is not fully defined, that it might or might not be less than the yield strength of the facestock, but that it is more likely to provide a permanent attachment, with a bond strength that would exceed the yield strengths of both the facestock and carrier film component.

In paragraphs 7 and 8, Mr. Emery reaches a similar conclusion with respect to the bond strengths of the adhesive layers 20, 64 and 74, 78 in the Smith patent.

In light of the foregoing, it is respectfully submitted that amended claim 1 and newly added claim 22 are patentable distinguishable from both Begelfer et al and Smith for at least the reason that neither reference discloses bond strengths between the facestocks and carrier sheets that are less than the yield strengths of the facestocks.

The examiner has also rejected claim 3 on the basis that both Begelfer and Smith inherently disclose facestocks that distort more than 1.0% in either the machine or cross machine directions when in an unrestrained state and exposed to temperatures above about 140°F. But see paragraphs 4-7 of the accompanying declaration by David A. Kitch, which clearly contradict the examiner's conclusion as to inherency. The rejection of claim 3 as being anticipated by either Begelfer et al or Smith should be withdrawn.

In EP 0681913 A1, the coextruded layers of the composite "are adhered to each other in a permanently combined state to provide a unitary coextrudate (Col. 2, lines 47-48; emphasis added). It follows, therefore, that the bond strengths at the interfaces between the coextruded layers would exceed the yield strengths of the layers, and that for at least this reason, EP 0681913 A1 fails to anticipate amended claim 1 and newly submitted claim 22.

In light of the foregoing, it is now believed that this application is in condition for allowance.

Respectfully submitted,



Maurice E. Gauthier  
Registration No. 20,798  
Gauthier & Connors LLP  
225 Franklin Street, Suite 2300  
Boston, Massachusetts 02110  
Telephone: (617) 426-9180, ext: 113